



AF 17W

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sundaram Ramakesavan
Serial No.: 09/234,559
Filed: January 20, 1999
For: System For Providing Video On
Demand With Pause Feature

§ Group Art Unit: 2614
§
§ Examiner: V. Kostak
§
§ Atty. Docket No.: ITL.0170US
§ P6678
§ Assignee: Intel Corporation

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL REPLY BRIEF

Sir:

This responds to the communication from the Examiner on Remand.

It is understood that the remand to the Examiner called upon the Examiner to either confirm receipt of the Applicant's reply or to reopen prosecution. As best as can be understood, the Examiner did neither of these. Rather than confirm receipt of the reply or reopen prosecution, the Examiner took the opportunity to augment his Examiner's Answer.

Further, the Examiner gave the Applicant two options and the Applicant hereby elects to maintain the appeal. Thus, pursuant to option 2, this paper may be considered a "Reply Brief."

The prior Board decision in this case made it clear that the step of automatically requesting a code for restarting the video could not be inherently taught unless there was only one way to use code to restore video. The Board found that this was not the case. Moreover, the Board required that any such code had to be requested automatically. Therefore, since the code could be requested manually or, for example, by the user, the limitation cannot be inherent because it could also be manually requested.

Date of Deposit: April 12, 2005

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Nonetheless, the Examiner, again, raises the same issues already decided by the Board, again insisting that the element could be inherently taught by a reference and claiming that, while the Examiner agrees that the code could be manually requested, somehow it would be difficult to do so. However, whether or not it is difficult to do so or not (which it most certainly would not be), it is still impossible for the element to be inherently taught if it is admitted that it is not necessarily the case that the element need be done automatically. Therefore, based on the Examiner's admission at the top of page 3, the rejection should be reversed on its face.

The Examiner contends that Dan uses codes to pause play or restore video. But this is not what the claim calls for. The claim calls for automatic requesting of code to enable play to be resumed later. The Examiner admits that Dan could have used a manual method. Just because that method is inferior, it is still a viable alternative. If inferiority of the alternative was the key, everything would be inherent (if the claimed invention were a good one).

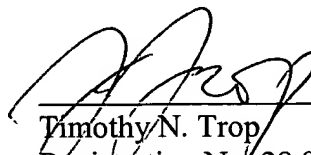
The assertion that it would be difficult to request the code in a non-automatic fashion, for example by pressing a button, is utterly baseless.

Since the Examiner has admitted that the element is not inherent and his other arguments are not commensurate with the scope of the claims, the rejection should be reversed. The claims are improperly read by the Examiner to essentially require nothing but transferring codes, a position which has already been expressly rejected in the prior Board decision.

Therefore, the Applicant requests that the Board again reverse the Examiner's positions that are essentially identical to those reversed previously.

Respectfully submitted,

Date: April 12, 2005



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